

REMARKS

Applicant has had an opportunity to review the outstanding Office Action issued by the U.S. Patent & Trademark Office in connection with this application, and now respectfully requests that the Examiner reconsider and/or reexamine the present application in view of the amendments and/or remarks contained in this paper.

Summary of the Outstanding Office Action

Claims 181-183, 185, 186, 188-193, 197-200, 202-212, 214, 215, 217-225, 227-234, 237-242, 244-254, 256, 257, 259-264 and 269-272 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,173,649 to Onishi ("Onishi").

Claims 181-183, 185, 186, 188-193, 197-200, 202-212, 214, 215, 217-225, 227-234, 237-242, 244-254, 256, 257, 259-264 and 269-272 stand provisionally rejected on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 26-55 and 57-73 of co-pending U.S. Patent Application No. 11/134,724.

Summary of the Amendments to the Claims

Claims 181, 200, 223 and 242 have been amended to more clearly identify the first layer as a print receptive layer.

Comments/Arguments

A terminal disclaimer is being filed herewith. Accordingly, it is respectfully requested that the Examiner withdraw the provisional non-statutory obviousness-type double patent rejection.

The rejections of the independent claims 181, 200, 223 and 242 are hereby traversed. Notably, the aforementioned claims all call for a splittable sheet structure that separates or divides in response to only a single bending action. As can be appreciated, according to the foregoing claims, there is a causal relationship between the bending action and the splitting or subdividing.

That is to say, the bending causes the sheet to actually split or subdivide. This feature is clearly not expressly taught or even fairly suggested by Onishi.

Onishi only discloses that repeated bending merely allows separation to be “made more easily.” Col. 6, l. 49-53. In other words, while the repeated bending may weaken the medium along the line 2, it does not result in actual splitting or separation. Rather, the actual splitting or separation is presumably accomplished or caused by some other action, e.g., such as tearing along the now weakened line 2. In any event, nowhere does Onishi teach that bending causes the medium to split or subdivide as claimed. Rather, Onishi merely states that separation is made more easily if the printing medium is bent several times along the easy-separating means 2. Making a result more easily obtained is not the same thing as actually causing the result.

Additionally, the claims call for separation in response to only a single folding action. Clearly, Onishi expressly calls for several bends, and even then Onishi does not explicitly teach that several bends actually result in separation. Rather, at best Onishi teaches that several bends may weaken the cut line 2 to allow for easier separation.

Therefore, Onishi does not teach that a single folding causes the medium to split or subdivide as claimed. Nevertheless, the Examiner alleges it would have been a “routine optimization” to replace several bends with a single one. Even assuming such an alteration or substitution is to some degree optimization, there is no suggestion from any teaching in Onishi how one could create a medium that would be reasonably likely to separate in response to a single bend. Accordingly, the optimization is not routine or obvious in view of Onishi. On the contrary, based on the teachings of Onishi, one of ordinary skill in the art is likely to conclude that replacing the several bends of Onishi with a single bend is only likely to make separation more difficult. Onishi teaches that several bends are required in order to make separation easier, and even then actual separation is not achieved (at least inasmuch as Onishi teaches). Accordingly, it is even less likely that a single bend would achieve actual separation. One of ordinary skill in the art would not read Onishi and conclude that a single bend would suffice when

several bends do not. Moreover, even if one were motivated to optimize the process as suggest by the Examiner, there is no teaching or even a suggestion in Onishi as to how to achieve that optimization.

Accordingly, claims 181, 200, 223 and 242 distinguish patentably over the prior art, along with any and all claims depending therefrom.

Claims 181, 200, 223 and 242 also further define patentably over the prior art. Notably, the claims call for a print receptive first layer and a second layer with the cut lines being made in the first layer.

The Office Action alleges that the disclosure of Onishi teaches a substrate with a glossy/ink-receptive layer formed thereon. Presumably, the Examiner means to equate the glossy/ink-receptive layer with the claimed first layer inasmuch as the ink-receptive layer is the layer in Onishi designated for printing. However, Onishi explicitly states that when the cut lines only partially extend through the width of the medium, they are not formed on the print receiving side or glossy layer (i.e., they are not in the first layer). Rather, as expressly taught by Onishi, when the cut line only partially extends through the print medium, the cut line or easy-separating means 2 is formed in the substrate only. According to Onishi,

“If the printing medium is provided with easy-separating means of a cut line, the depth of the cut of the cut line is equal to or lesser than the full thickness of the substrate. In this case, **it is necessary that the cut line is formed in the substrate** reaching the glossy layer and the ink acceptable layer.

If the cut of the cut line reaches the glossy layer and the ink acceptable layer, the ingredients of those layers will be scattered in the form of powdery particles possibly soil the printing medium and the printer inside.” Col. 7, l. 3-12 [Emphasis Added].

Therefore, the disclosed glossy/ink receptive layer disclosed by Onishi does not read on the claimed first layer inasmuch as no cut lines are formed therein. Therefore, claims 181, 200, 223 and 242 further define patentably over the prior art.

Conclusion

For at least the reason(s) presented above, all the claims now remaining in the application are in condition for allowance, and accordingly, an early indication of the same is earnestly solicited.

Of course, if the Examiner feels that personal contact would facilitate expedited disposition of the present application, then he/she is hereby invited to contact the below signed representative of the Applicant.

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Date

Respectfully submitted,

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